



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,313	01/23/2002	Chad Stevens	10013604-01	8004

7590

04/19/2004

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

OSORJO, RICARDO

ART UNIT	PAPER NUMBER
----------	--------------

2673

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,313

Applicant(s)

STEVENS ET AL.

Examiner

RICARDO L OSORIO

Art Unit

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,9,10 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,9,10 and 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 9, 10, 13, 16 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Comiskey 6,473,072).

Regarding claim 1, Comiskey teaches of a whiteboard apparatus (Fig. 12a, reference character 120, and col. 14, lines 50-52) comprising:
an electronic paper display device configured to display an image (col. 13, lines 58-61);
and a writing surface (Fig. 12b, reference character 129) arranged in superimposed relationship with the electronic paper display device (col. 14, lines 47-49). Note that the protecting layer or coating is the superimposed writing surface). Also, Comiskey further teaches of user interface device for enabling a user to select one of a plurality of reference images to be displayed on the electronic paper display device comprising a predefined image which is used to assist the user in drawing a related image over the reference image without having to first draw the reference image (col. 14, lines 47-53 and col. 16, lines 48-68. Any underlying image over which the user may write constitutes a reference image). Also, the drawing system of Comiskey can store and recall images, which clearly

Art Unit: 2673

provides for selection from different stored reference images (see Comiskey, col. 17, lines 2-6).

Regarding claim 2, Comiskey teaches of the electronic paper display device comprising:

a plurality of image elements, each of the image elements having one or more charged particles (Fig. 1a, reference character 16, and col. 6, lines 36-39. Note that each one of the needle-like particles is an image element); and logic configured to display the image by controlling the orientation of the charged particles (col. 6, lines 39-45).

Regarding claim 3, Comiskey teaches that the electronic paper display employs electronic ink technology (col. 5, line 45).

Regarding claim 4, Comiskey further teaches of a network interface device configured for communication with a communication network and wherein the image displayed on the electronic paper display is received via the communication network (col. 16, lines 48-52 and 60-67. Note that the communications device and appropriate logic circuitry used to download information from the web or, internet, requires a network interface).

Regarding claim 9, Comiskey further teaches of a scanning device configured to convert a document to an electronic image to be displayed on the electronic paper display device (col. 17, lines 2-6).

Regarding claim 10, Comiskey teaches of a method comprising the steps of :

Providing an electronic paper display device configured to display an image (col. 13, lines 58-61) on a whiteboard (Fig. 12a, reference character 120, and col. 14, lines 50-52);

Art Unit: 2673

arranging a writing surface (Fig. 12b, reference character 129) in superimposed relationship with the electronic paper display device (col. 14, lines 47-49. Note that the protecting layer or coating is the superimposed writing surface); and furthermore enabling a user to select one of a plurality of reference images to be displayed on the electronic paper display device comprising a predefined image which is used to assist the user in drawing a related image over the reference image without having to first draw the reference image and displaying the image on the electronic paper display device (col. 14, lines 47-53 and col. 16, lines 48-68. Any underlying image over which the user may write constitutes a reference image). Also, the drawing system of Comiskey can store and recall images, which clearly provides for selection from different stored reference images (see Comiskey, col. 17, lines 2-6).

Regarding claim 13, Comiskey further teaches that the electronic paper display employs electronic ink technology (col. 5, line 45).

Regarding claim 16, Comiskey further teaches of scanning the image from a document (col. 17, lines 2-3).

Regarding claim 18, Comiskey further teaches that the electronic display device comprises: a plurality of image elements, each of the image elements having one or more charged particles (Fig. 1a, reference character 16, and col. 6, lines 36-39. Note that each one of the needle-like particles is an image element); and logic configured to display the image by controlling the orientation of the charged particles (col. 6, lines 39-45).

Art Unit: 2673

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 5, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey et al. (6,473,072) in view of Chery et al (6,177,927).

Regarding claims 5, 14 and 15, Comiskey fails to teach that the reference image comprises a Cartesian plane, or a template of a flowchart.

Chery teaches of a reference image comprising a Cartesian plane, or a template of a flowchart: Chery teaches of a large variety of background, or reference, images over which a user may write on the writing surface which may include a spreadsheet, blueprints, text, graphs, graphics (see Chery, col. 24, lines 30-50). Also, Chery teaches that images for the background images can be created with graphics programs such as VISIO, CAD programs, or other programs used to make documents, and also, that the reference image can be an image from a webpage (see Chery, col. 24, line 62-col. 25, line 5, and col. 25, lines 33-43). Finally, Chery teaches of a Cartesian coordinate that is transposed on the writing surface; the corners of the monitor image area are defined as (0,0), (0,H), (W,0) and (W,H) (see Chery, Figs. 11B and 11C, and col. 49, lines 47-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a reference image showing a Cartesian plane, or template, as taught by Chery, in the device of Comiskey, so that the user can write a stroke on the writing surface and know the precise stylus location (see Chery, col. 49, line 66-col. 50,

Art Unit: 2673

line 2). Also, it is well known in the art of graphics that a program such as CAD can be used to create any desired graphical image such as a Cartesian coordinate, a graph, flowchart, etc.

2. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey (see above) in view of applicant's admitted prior art (APA, hereafter).

Regarding claim 17, Comiskey fails to teach of printing the image displayed on the electronic paper display and the contents of the writing surface.

APA teaches of printing the combined result of the image displayed on the electronic paper display and the contents of the writing surface (see application, page 2, lines 2-5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to print the combined image, as taught by APA, in the device of Comiskey because it is well known in the art of electronic whiteboards to integrate a printer which can print both original images and updated images, for example, to provide an updated hard copy of the lecture or conference to all the participants.

Response to Arguments

2. Applicant's arguments filed 2-9-2004 have been fully considered but they are not persuasive.

3. Applicant argues that neither Comiskey nor Chery disclose, teach or suggest "enabling the user to select one of a plurality of reference images to be displayed on the electronic paper display device, the reference images comprising a predefined image

Art Unit: 2673

which is used to assist the user in drawing a related image over the reference image without having to first draw the reference image”.

Examiner disagrees because Comiskey further teaches of user interface device for enabling a user to select one of a plurality of reference images to be displayed on the electronic paper display device comprising a predefined image which is used to assist the user in drawing a related image over the reference image without having to first draw the reference image (col. 14, lines 47-53 and col. 16, lines 48-68. Any underlying image over which the user may write constitutes a reference image). Furthermore, the drawing system of Comiskey can store and recall images, which clearly provides for selection from different stored reference images (see Comiskey, col. 17, lines 2-6).

In addition, examiner disagrees because Chery teaches of a large variety of background, or reference, images over which a user may write on the writing surface which may include a spreadsheet, blueprints, text, graphs, graphics (see Chery, col. 24, lines 30-50). Also, Chery teaches that images for the background images can be created with graphics programs such as VISIO, CAD programs, or other programs used to make documents, and also, that the reference image can be an image from a webpage (see Chery, col. 24, line 62-col. 25, line 5, and col. 25, lines 33-43. Reference images can be created, stored and retrieved by selection with the use CAD programs among many other programs).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 2673

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricardo L. Osorio whose telephone number is (703) 305-2248. The examiner can normally be reached on Mon-Thu from 7:00 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala, can be reached at 305-4938.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to: (703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



BIPIN SHALWALA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Ricardo L. Osorio
Examiner
Art Unit: 2673

RLO
April 12, 2004